

REMARKS

At the time of the First Office Action dated August 20, 2007, claims 1-12 were pending and rejected in this application.

CLAIMS 1-12 ARE PROVISIONALLY REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-18 OF COPENDING U.S. APPLICATION NO. 10/758,853 (HEREINAFTER THE '853 APPLICATION)

This rejection is traversed. As provided for in M.P.E.P. § 804(I)(B):

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. (emphasis added)

With regard to Nonstatutory Double Patenting rejections, M.P.E.P. § 804(II)(B)(1) states that

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

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2 The Examiner's statement of the rejection, however, evidences a complete lack of these
3 factual inquiries in the Examiner's analysis. Instead, the Examiner alleges that "[a]lthough the
4 conflicting claims are not identical, they are not patentably distinct from each other because it is
5 obvious that the claimed combinations of Claims 1-18 of Application No. 10/758,853 cover the
6 instant claimed application/invention." Since (i) the Examiner has not established that these
7 Graham factual inquiries were part of the Examiner's analysis; (ii) the Examiner has not identified
8 the specific limitations recited in the present claims that are not allegedly disclosed by the claims
9 1-18 of the '853 application; and (iii) the Examiner has not established why these specific
10 limitations are obvious in view of claims 1-19 of the '853 application, Applicants respectfully
11 submit that the Examiner has failed to establish a proper rejection of obviousness-type double
12 patenting.

13
14 Applicants are also unclear as to how the '853 application could apply as prior art against
15 the present application since the '853 application has a later filing date than the present
16 application. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-12
17 under obvious-type double patenting based upon the '853 application is not factually or legally
18 viable and, hence, solicit withdrawal thereof.

19
20 **CLAIMS 1-12 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY SUZUKI**
21 **ET AL., U.S. PATENT PUBLICATION NO. 2002/0032616 (HEREINAFTER SUZUKI)**

22 On pages 2-8 of the First Office Action, the Examiner asserted that Suzuki discloses the
23 invention corresponding to that claimed. This rejection is respectfully traversed.

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2 The factual determination of anticipation under 35 U.S.C. § 102 requires the identical
3 disclosure, either explicitly or inherently, of each element of a claimed invention in a single
4 reference.¹ Moreover, the anticipating prior art reference must describe the recited invention
5 with sufficient clarity and detail to establish that the claimed limitations existed in the prior art
6 and that such existence would be recognized by one having ordinary skill in the art.² As part of
7 this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the
8 meaning of the elements in light of the specification and prosecution history, and (c) identify
9 corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not
10 been met.

11
12 Claim 1

13 At the outset, Applicants note that the Examiner's analysis relies on generalizations and
14 **ignores** the specific language of the claims. Applicants also note that the Examiner's cited
15 passages of Figures 3-4 and 6-7 as well as paragraphs [0020]-[0023] and [0030] describe what
16 Applicants has already admitted is prior art (i.e., see Fig. 1 of Applicants' specification).

17
18 For example, regarding the claimed "plurality of mobile server wallets each wallet having
19 an association with a corresponding subscriber in a wireless service provider network," the
20 Examiner cited Figures 3-5 and 6-7 while stating "Suzuki displays figure which depict a system

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 that is capable of facilitating the transactions between multiple mobile server wallet's."
2 Completely absent from the Examiner's analysis is any identification of a teaching within Suzuki
3 that "each wallet having an association with a corresponding subscriber," as claimed.

4
5 Moreover, regarding the claimed "filter plug-in coupled to said proxy server and
6 configured to intercept selected payment messages flowing through the proxy server and to route
7 said payment messages to selected ones of said mobile server wallets," the Examiner cited
8 paragraphs [0028]-[0029] and [0033]-[0038], while asserting "[u]pon system authentication
9 within the network, payment messages are routed back and forth via the system through the filter
10 plug-in coupled to the proxy server." Applicants have reviewed the Examiner's cited passage
11 and are entirely unclear as to where Suzuki specifically identically discloses the claimed proxy
12 server and the claimed filter plug-in.

13
14 Moreover, despite the claimed reciting to "selected ones of said mobile server wallets,"
15 the Examiner's cited passages of paragraphs [0028]-[0029] and [0033]-[0038] only refer to a
16 single wallet. The only discussion, within the Examiner's cited passages, of multiple wallet
17 servers is found in paragraph [0030], which is reproduced below:

18 Also, a preferable mode is one wherein the payment system is provided with a plurality
19 of the wallet servers, and the information out of which the predetermined item is to be selected by
20 the contents converting section is information used by the user to select the wallet server for the
21 payment out of the plurality of the wallet servers.
22

23 Completely absent from this passage, however, is a detailed discussion of how the multiple
24 wallet servers are integrated into the system or specifically how payment messages are to be
25 routed to selected ones of the mobile server wallets. Thus, for the reasons stated above, the

Examiner has failed to establish that Suzuki identically discloses the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Claim 2

Dependent claim 2 recites, in part, "a plurality of profiles communicatively linked to said filter plug-in," and to teach this limitation the Examiner cited paragraph [0030]. However, this passage (previously reproduced above) is silent as to a filter plug-in and as to profiles that "[specify] a merchant configured to engage in mobile commerce transactions through said wireless service provider network," as claimed. In this regard, Applicants note that the Examiner's analysis fails to establish why the Examiner believes paragraph [0030] identically discloses this limitation. Thus, the Examiner has failed to establish that Suzuki identically discloses the claimed invention, as recited in claim 2, within the meaning of 35 U.S.C. § 102.

Claims 5 and 9

Independent claims 5 and 9 are also directed to the concept of wallets associated with a specific subscriber and routing filtered payment messages associated with specific subscribers to the wallets. However, as noted above with regard to claim 1, the Examiner has failed to specifically identify a teaching in Suzuki that identically discloses these features. Thus, the Examiner has failed to establish that Suzuki identically discloses the claimed invention, as recited in claims 5 and 9, within the meaning of 35 U.S.C. § 102.

For above-described reasons, the Examiner has failed to establish that Suzuki identically discloses the claimed invention, as recited in claim 1-12, within the meaning of 35 U.S.C. § 102.

1 Applicants, therefore, respectfully submit that the imposed rejection of claims 1-12 under 35 U.S.C.
2 § 102 for anticipation based upon Suzuki is not factually viable and, hence, solicits withdrawal
3 thereof.

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Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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